



EFW

Docket No. 1293.1867

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jin-han KIM et al.

Serial No. 10/643,166

Group Art Unit: 2133

Confirmation No. 3597

Filed: August 19, 2003

Examiner: Linh Thi Nguyen

For: APPARATUS AND METHOD FOR MODULATING ADDRESS DATA, APPARATUS AND METHOD FOR DEMODULATING ADDRESS DATA THEREFOR, AND RECORDING MEDIUM FOR RECORDING MODULATED ADDRESS DATA

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed July 3, 2006, having a shortened period for response set to expire on August 3, 2006, the following remarks are provided.

**I. Provisional Election of Claims**

Applicants provisionally elect claims 1-32 and 43-58 (Group I) in response to the preliminary restriction requirement set forth in the Office Action.

**II. Applicants Traverse the Requirement**

On pages 2-3 of the Office Action, the Examiner asserts that Groups I and II are distinct inventions related as subcombinations usable together in a single combination. By way of review, in order to maintain a prima facie case for restriction based upon subcombinations, the Examiner needs to provide evidence that the subcombinations have separate utility, and are "usable together in a single combination." MPEP 806.05(d). By way of example and as explained in MPEP 806.05(b), where claims are drawn to a combination  $AB^b$  and claims are drawn to specific subcombination  $B^{sp}$ , restriction is proper since the subcombination of  $B^{sp}$  is separately patentable as compared to the combination of  $AB^b$ , where the general technology of B is claimed in the combination. As such, in order to substantiate such a restriction requirement,

there needs to be evidence of record that the combination claims recite a general version of the subcombination claims.

On page 2 of the Office Action, the Examiner asserts that the Group I is a subcombination and Group II is a combination not requiring the particulars of the subcombination of Group I. However, the claims of Group II do not recite modulating, even generally. Thus, it is respectfully submitted that the claims of Group II do not recite, as a recited feature, an affirmative act of modulating as would be required for Group II to be a combination involving the general technology of Group I. As such, it is respectfully submitted that there is insufficient evidence that the invention as claimed in Group II are a combination within the meaning of the MPEP 806.05.

Insofar as Groups I and II are concerned, it is believed that claims 33-40 and 59-63 are so closely related to elected claims 1-32 and 43-58 of Group I that they should remain in the same application to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the invention recited in claims 33-40 and 59-63 of Group II. There have further been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims for both modulating and demodulating in the same field of technology. Thus, while it is noted that the Examiner has identified different sub- classifications for the claims in Groups I and II, it is believed that classification is not conclusive on the question of restriction.

It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claim by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04- §806.04(i), §808.01(a) and §808.02). Such evidence is required in order for meaningful review to be provided under the Administrative Procedures Act, 5 U.S.C. §706. In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001). As such, beyond showing separate classifications in subclasses of the same class, it is respectfully submitted that the Examiner has not set forth sufficient evidence to show that the Examiner will experience a serious burden without imposing restriction which is

out of proportion with the serious burden and inconvenience visited upon the applicant if restriction is required.

III. Conclusion

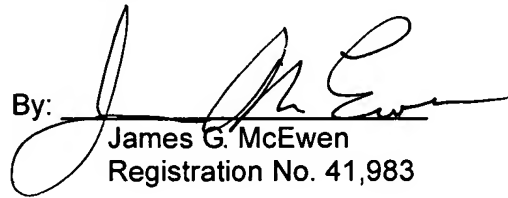
Upon review of references involved in this field of technology, when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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